REMARKS

Specification

The specification stands objected to under 35 U.S.C. §132(a) for introducing new matter into the disclosure. Examiner asserts that the added material which is not supported by the original disclosure is as follows: on Page 12 at Paragraph 44, expanded vinyl *and* vinyl with a layer of foam. Applicant respectfully disagrees with Examiner's assertion.

Page 12, Paragraph 44 previously read, "Examples of such materials include expanded vinyl, which is vinyl with a layer of foam that imparts a soft, textured feel ...." As would be appreciated by one ordinarily skilled in the art, expanded vinyl is vinyl with air injected into it. It is not defined as vinyl with a layer of foam. Therefore, the phrase "which is" was clearly a mistake. Applicant corrected this mistake by removing the "which is" language so that the passage reads, "Examples of such materials include expanded vinyl; vinyl with a layer of foam that imparts a soft, textured feel ...."

Applicant respectfully submits that this previous amendment did not introduce new matter into the disclosure since, as would be appreciated by one ordinarily skilled in the art, expanded vinyl is not necessarily vinyl with a layer of foam and that the amendment merely corrected this mistake.

Applicant respectfully submits that the specification is currently in condition for allowance. Reconsideration and withdrawal of this objection is respectfully requested.

Claim Rejections – 35 U.S.C. §112

Claims 1-7, 23-31, 47-56, 72-79, and 95-101 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Examiner

asserts that the specification as originally filed fails to provide support for the limitation of the first side, or top surface, being flat.

Information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter. MPEP 2163.06.

Examiner is thanked for the interview on July 21, 2005. In that interview, Examiner agreed that the limitation of the first side, or top surface, being continuous and flat is supported by the original disclosure and that the §112 rejection would be withdrawn.

Support for this limitation is found in FIGS. 1, 3, 4A, 6, 9 and 10 of the application as originally filed which clearly show that the top surface of the body (skin layer) is continuous and flat from a first end of the skin layer to a second end of the skin layer opposite the first end.

For example, in FIG. 1, the top surface 102 of body 104 is clearly continuous and flat from the left end (first end) of body 104 all the way to the right end (second end) of body 104. There are no interruptions or protrusions in top surface 102 and top surface 102 is not defined by a collection of several separated surfaces.

Paragraph 44, Page 12 of the specification as originally filed further supports this flat limitation:

> Skin layer 104 can be formed from a variety of materials. Examples of such materials include expanded vinyl, which is vinyl with a layer of foam that imparts a soft, textured feel; leather; plastic sheeting; plastic roll stock; any type of foam product; polyurethane; polyester; urethane; woven fabrics; rubber material; foil material; paper material; or any other material which could act as a covering to a hand support system. Any

material utilized may be supported or unsupported. If skin layer 104 is formed from expanded vinyl, the vinyl surface may be **smooth** or textured.

Merriam Webster's Collegiate Dictionary, 10th Edition provides the following definitions:

smooth *adj*	1 a (1) : having a continuous or even surface
flat *adj*	3 : having a relatively smooth or even surface
	4: arranged or laid out so as to be level or even

Applicant respectfully submits that the limitation of the first side being flat is supported by FIGS. 1, 3, 4A, 6, 9 and 10 showing a relatively smooth and even surface and by the specification specifically stating that the surface may be smooth.

Additionally, the same limitation was recently added to Parent Application Serial No. 09/874,940 in the Amendment dated March 15, 2005. Examiner entered the Amendment without raising a §112 rejection. The drawings relied upon for that Amendment (FIGS. 1, 3, 4, 6, 9, and 10) are essentially the same as the drawings in the present application (FIGS. 1, 3, 4A, 6, 9, and 10). Also, the language in the specification referring to this flat limitation is nearly identical to the language referred to above. Page 7, lines 19-23 and Page 8, lines 1-2 of the Parent Application read:

> ... Skin layer 104 can be formed from a variety of materials. Examples of such materials include expanded vinyl, which is vinyl with a layer of foam that imparts a soft, textured feel, leather, plastic sheeting, plastic roll stock, any type of foam product, polyurethane, urethane, woven fabrics, rubber material, foil material or any other material which could act as a covering to a hand support system. If skin layer 104 is formed from expanded vinyl, the vinyl surface may be **smooth** or textured ....

In the Office Action dated June 30, 2005 for the present application, Examiner stated that Applicant discloses a textured grip in paragraphs 0012 and 0066 through 0068 of the specification. However, this disclosure of a textured grip merely represents one embodiment of the invention. It does not exclude a flat grip embodiment. In fact, paragraphs 066 through 0068 cited by Examiner refer to FIG. 14 as illustrating the textured grip. By comparison, FIGS. 1, 3, 4A, 6, 9, and 10, along with the text of the specification discussed above, clearly illustrate a grip with a flat top surface.

Claims 2, 26, 51, and 74 were canceled in the Amendment dated June 8, 2005. Therefore, the rejection of Claims 2, 26, 51, and 74 is now moot.

Applicant respectfully submits that Claims 1, 3-7, 23-25, 27-31, 47-50, 52-56, 72-73, 75-79, and 95-101 comply with the written description requirement under 35 U.S.C. §112, first paragraph, and that they are currently in condition for allowance.

Reconsideration and withdrawal of the rejection is respectfully requested.

Amendments to Claims

Applicant respectfully submits that the amendments to the claims find support in the application as originally filed.

Specifically, support for the hand railing and the stretchable layer being releasably adhered to the outer surface of the hand railing is found in FIGS. 9-10 and in the Specification on Page 19, Paragraph 59, where it states, "Four-way stretchable material layer 304 is releasably adhered to railing 302."

Support for the skin layer being axially wrapped around the outer surface of the hand railing is found in FIGS. 9-11 and on Page 20, Paragraph 61.

Support for the edges of the skin layer not overlapping is found in the Specification on Page 5, Paragraph 10, where it states, "As an alternative to folding the

grip such that the edges overlap, the grip may be folded so that the edges do not overlap...."

Applicant also amended the claims to replace "body" with "skin layer." Support for this amendment is found in the Specification on Page 12, Paragraph 43, where it states, "Grip 100 has a skin layer (or body) 104 ...."

The claims were also amended to replace "first side" and "second side" with "top surface" and "bottom surface" in order to make the language more clear. Support for this amendment is found in all of the figures, which clearly show the skin layer having a top surface and a bottom surface.

Applicant respectfully submits that no new matter has been introduced by these amendments to the claims and that the claims are currently in condition for allowance.

Additional Arguments

It is noted that in co-pending Parent Application Serial No. 09/874,940, Examiner cited Shomo (U.S. Patent No. 4,660,832) in a §103 rejection in an Office Action dated June 17, 2005. The following arguments are presented to address the possibility of a similar rejection in the present application.

For a §103 obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*,

165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d 1016, 1023 (Fed. Cir. 1996).

Amended Claim 1 recites a system for providing a grip for a hand railing or grab bar comprising "a hand railing or grab bar having an outer surface; a skin layer axially wrapped around said outer surface of said hand railing or grab bar such that the edges of said skin layer do not overlap, said skin layer having a top surface, a bottom surface, a first end, and a second end opposite said first end, wherein said top surface is continuous and flat from said first end to said second end; a stretchable material ... adhered to said bottom surface of said skin layer; and a releasable adhesive disposed on said bottom surface of said stretchable material, wherein said stretchable material is releasably adhered to the outer surface of said hand railing or grab bar."

Shomo fails to disclose a hand railing or grab bar, and a stretchable layer releasably adhered to the outer surface of the hand railing or grab bar, as recited in Claim 1. Shomo is only directed towards a handle for use on products such as "tennis rackets, racquetball rackets, golf clubs, baseball bats, and various other impact devices such as hammers, and the like." Reference numeral 13a, cited by Examiner, is not a hand railing or grab bar, but rather the handle of tennis racket 12. (FIGS. 1-3; Col. 2, lines 61-68). The handle of a tennis racket (or golf club, hammer, etc.) does not constitute hand railing. As would be appreciated by one ordinarily skilled in the art, hand railing and grab bars provide hand guidance and support along a structure. When a user grabs hand railing or a grab bar and applies force to it, neither the hand railing/grab bar nor the structure to which it is attached move in a significant way, thereby providing something fixed and stable for the user to grab. The impact devices of Shomo, such as the tennis racket handle, are completely different. When a user grabs a tennis racket and applies force to it, both the handle and the racket move significantly, allowing the user to swing

the racket. Therefore, it is clear that the tennis racket handle cited by Examiner does not constitute hand railing or a grab bar as recited in Claim 1.

Furthermore, there is no suggestion or incentive that would motivate one skilled in the art to modify Shomo so that it has a stretchable layer releasably adhered to hand railing or a grab bar. As mentioned above the purpose of the handle in Shomo is to accommodate impact devices that have significant freedom of movement, such as tennis rackets, golf clubs, hammers, and the like. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. MPEP 2143.01. Applying the device of Shomo to hand railing or a grab bar would prevent the device from being used on any of the impact devices in Shomo, since the stretchable layer cannot be adhered to both an impact device, requiring freedom of movement, and a railing/grab bar, requiring stability, at the same time. Such a modification would render the device in Shomo unsatisfactory for its intended purpose. Therefore, there is no suggestion or motivation to make such a modification.

Shomo also fails to disclose a skin layer axially wrapped around the outer surface of a hand railing or grab bar such that the edges of the skin layer do not overlap, as recited in Claim 1. Reference numeral 17a in Shomo, cited by Examiner, is not a *skin* layer. *Merriam Webster's Collegiate Dictionary, 10th Edition* provides the following definition:

> **skin** *n* 4 : a sheathing or casing forming the outside surface of a structure

As seen in FIGS. 1-3, outer shell 17a is not *the outside surface* of the structure in Shomo. Rather, a "conventional or standard tennis racket covering material, such as leather, vinyl, plastic or other suitable material, is indicated by the numeral 25, and it is illustrated

as being wrapped around the outer periphery of the outer shell 17 in a conventional manner ...." (Col. 3, lines 43-51). Therefore, covering material 25 is the skin layer, not shell 17a. As seen in FIG. 1, covering material 25 is *spirally* wrapped, not *axially* wrapped around handle 13. It is also evident from FIG. 1 that the edges of covering material 25 *overlap*, since the outer surface of covering material 25 is not level, but rather has steps. Therefore, the skin layer in Shomo is not axially wrapped around the outer surface of a hand railing or grab bar such that the edges of the skin layer do not overlap, as required by Claim 1.

Furthermore, there is no suggestion or incentive that would motivate one skilled in the art to modify Shomo so that covering material is axially wrapped around the outer surface of a hand railing or grab bar such that the edges of the skin layer do not overlap.

In the Advisory Action dated September 8, 2005, Examiner states that the motivation to modify the references was found in the knowledge generally available to one of ordinary skill in the art. However, Examiner does not specify the claim limitation or the modification to which Examiner is referring. Therefore, it is unclear what claim limitation Examiner is addressing.

Even assuming that Examiner is referring to all the limitations not disclosed in Shomo, Applicant respectfully submits that it is not generally known to apply the handle of a tennis racket, or other impact device, to a hand railing. As discussed above, these are two completely different fields of use. It is also not generally known to axially wrap the skin layer of a tennis racket handle around the outer surface of a railing such that the edges of the skin layer do not overlap. As stated in MPEP 2144.03(A), it "is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based." It is respectfully requested that evidence be provided, if possibly citable from the prior art, to

prove that the prior art teaches all of the limitations of Claim 11, including a railing having an outer surface, and a skin layer axially wrapped around the outer surface of the railing such that the edges of the skin layer do not overlap, or the rejection must be withdrawn. Broad conclusory statements standing alone are not evidence. MPEP 2144.03(C).

Applicant respectfully submits that Shomo fails to disclose all elements of Claim 1 and that there is no suggestion or incentive that would have motivated the skilled artisan to modify Shomo in order to include all the elements of Claim 1.

It is further noted that in co-pending Parent Application Serial No. 09/874,940, Examiner cited Johnson (U.S. Patent No. 2,425,245) in combination with Shomo in a §103 rejection in an Office Action dated October 11, 2005. Examiner argued that Johnson, as seen in Figure 6, shows a grip comprising a skin layer axially wrapped around the outer surface of a handrail such that the edges of the skin layer do not overlap, and that it would have been obvious to one having ordinary skill in the art to modify the prior art such that the skin layer device of Shomo would be wrapped around the outer surface of the railing as taught by Johnson in order to provide for ease of application and removal. The following arguments are presented to address the possibility of a similar rejection in the present application.

Despite Examiner's assertion, Johnson does not disclose a grip comprising a skin layer axially *wrapped* around the outer surface of a *hand railing or grab bar*, as recited in Claim 1.

The grip in Johnson is disposed over "the usual handle 4 of a conventional air hammer ...." (Col. 3, lines 8-12). As would be appreciated by one ordinarily skilled in the art, the handle of an air hammer does not constitute a hand railing or grab bar. As discussed above, hand railing and grab bars provide hand guidance and support along a

structure. When a user grabs hand railing or a grab bar and applies force to it, neither the hand railing/grab bar nor the structure to which it is attached move in a significant way, thereby providing something fixed and stable for the user to grab. The handle of the air hammer in Johnson is completely different. When a user grabs the handle of an air hammer and applies force to it, both the handle and the air hammer move significantly, allowing the user to apply the air hammer to a variety of different locations or targets. Therefore, it is clear that the handle of the air hammer in Johnson does not constitute hand railing or a grab bar as recited in Claim 1.

Furthermore, the grip in Johnson is not *wrapped* around the handle of the air hammer. *Merriam Webster's Collegiate Dictionary, 10th Edition* provides the following definition:

wrap *vb* **wrapped** 1 a: to cover esp. by winding or folding

The grip in Johnson is not wound or folded around the handle of the air hammer. As seen in FIGS. 2, 3, 4, and 6, the grip is formed in the shape "of an inverted U, cross-sectionally, and is adapted to be fitted directly over the usual handle 4 of a conventional air hammer ...." (Col. 3, lines 8-12). Therefore, the grip is not wrapped around the handle of the air hammer, but rather slid onto the handle after it has already been formed in the U-shape. Applicant cannot find, nor has Examiner cited, any mention in Johnson of the grip being wound, folded, or otherwise wrapped around the handle.

Since neither Shomo nor Johnson disclose a grip comprising a skin layer axially *wrapped* around the outer surface of a *hand railing or grab bar*, they cannot teach these limitations in combination. Therefore, Applicant respectfully submits that the cited prior art fails to disclose every limitation of Claim 1 and that there is no incentive or suggestion that would motivate one skilled in the art to modify the prior art to include

the limitations of Claim 1. Applicant respectfully submits that Claim 1 is currently in condition for allowance.

The same arguments made above with respect to the patentability of Claim 1 are also applicable to the patentability of Claims 25, 50, 73, 96, 97, 98, and 100 as well. Applicant respectfully submits that Claims 25, 50, 73, 96, 97, 98, and 100 are currently in condition for allowance.

Since Claims 3-7, 23-24, 27-31, 47-49, 52-56, 72, 75-79, 95, 99, and 101 depend from Claims 1, 25, 50, 73, 98, and 100 respectively, they are also patentable as they contain the same limitations as their respective parent claims.

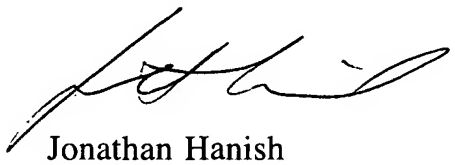
Additionally, Claims 3, 27, 52, and 75 all recite "a light emitter coupled with said top surface of said skin layer." Shomo fails to disclose a light emitter coupled with the top surface of the skin layer. Furthermore, it would not have been obvious to one of ordinary skill in the art to modify the tennis racket (or other impact device) handle in Shomo to include a light emitter. There is no suggestion or incentive that would motivate one having ordinary skill in the art to combine a light emitter with the impact device handle of Shomo. The handle of a tennis racket, golf club, baseball bat, hammer, or other impact device would not benefit from the inclusion of a light emitter since the activities associated with these type of devices do not take place in the dark. It is extremely unlikely that people would use any of these impact devices in an environment that is so poorly lit that it would require or in any way benefit from a light emitter being disposed on the handle of the impact device.

Therefore, Applicant respectfully submits that Claims 3-7, 23-24, 27-31, 47-49, 52-56, 72, 75-79, 95, 99, and 101 are currently in condition for allowance.

If the Examiner has any questions regarding this application, the Examiner may telephone the undersigned at 775-586-9500.

Respectfully submitted,
SIERRA PATENT GROUP, LTD.

Dated: October 31, 2005



Jonathan Hanish
Reg. No.: 57,821

Sierra Patent Group, Ltd.
P.O. Box 6149
Stateline, NV 89449
(775) 586-9500
(775) 586-9550 Fax